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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,804	09/30/2003	Matthias Boese	W0029/7005	2223
64967 -	7590 10/04/2006		EXAMINER	
LAW OFFICES OF PAUL E. KUDIRKA 40 BROAD STREET			FLETCHER III, WILLIAM P	
SUITE 300	OIREEI		ART UNIT	PAPER NUMBER
BOSTON, MA 02109		1762		

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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	Application No.	Applicant(s)	,
Office Action Summer	10/675,804	BOESE, MATTHIAS	
Office Action Summary	Examiner	Art Unit	
	William P. Fletcher III	1762	
The MAILING DATE of this communication a Period for Reply	appears on the cover sheet with	h the correspondence address	
A SHORTENED STATUTORY PERIOD FOR REI WHICHEVER IS LONGER, FROM THE MAILING - Extensions of time may be available under the provisions of 37 CFR after SIX (6) MONTHS from the mailing date of this communication If NO period for reply is specified above, the maximum statutory per - Failure to reply within the set or extended period for reply will, by state that the period for reply will be set or extended period for reply will be set or extended period for reply will by state any reply received by the Office later than three months after the material patent term adjustment. See 37 CFR 1.704(b).	DATE OF THIS COMMUNIC 1.136(a). In no event, however, may a rejicted will apply and will expire SIX (6) MONT	ATION. ply be timely filed HS from the mailing date of this communication NDONED (35 U.S.C. § 133).	
Status			
1) Responsive to communication(s) filed on 03	3 March 2006.		
	his action is non-final.		
3) Since this application is in condition for allow		rs, prosecution as to the merits	is
closed in accordance with the practice unde			-
Disposition of Claims			
4) Claim(s) <u>1-21</u> is/are pending in the applicati	on		
4a) Of the above claim(s) is/are withd			
5) Claim(s) is/are allowed.	mawn nom consideration.		
6)⊠ Claim(s) <u>1-21</u> is/are rejected.			
7) Claim(s) is/are rejected.			
	dlar alaatian ransiransant		
8) Claim(s) are subject to restriction and	a/or election requirement.		
Application Papers			
9) ☐ The specification is objected to by the Exam	iner.		
10)⊠ The drawing(s) filed on <u>30 September 2003</u>	is/are: a)⊠ accepted or b)□	objected to by the Examiner.	
Applicant may not request that any objection to t	he drawing(s) be held in abeyand	e. See 37 CFR 1.85(a).	
Replacement drawing sheet(s) including the corr			(d).
11) The oath or declaration is objected to by the			. ,
Priority under 35 U.S.C. § 119			
12)⊠ Acknowledgment is made of a claim for forei	ian priority under 35 H S C &	110(a)-(d) or (f)	
a)⊠ All b)□ Some * c)□ None of:	ight phonty under 55 5.5.5. §	113(4)-(4) 61 (1).	
1. ☐ Certified copies of the priority docume	ents have been received		
2. Certified copies of the priority docume		unlication No	
	•	•	
3. Copies of the certified copies of the p	-	eceived in this National Stage	
application from the International Bure	, , , ,	and the same	
* See the attached detailed Office action for a l	ist of the certified copies not r	eceivea.	
Attachment(s)	🗖		
I) ⊠ Notice of References Cited (PTO-892) ☑ Notice of Draftsperson's Patent Drawing Review (PTO-948)	4) Interview Su Paper No(s)	ımmary (PTO-413) /Mail Date	
B) Information Disclosure Statement(s) (PTO/SB/08)	_	ormal Patent Application	
Paper No(s)/Mail Date <u>09/30/2006</u> .	6) Other:	<u>-</u> ·	
Patent and Trademark Office			

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DETAILED ACTION

- 1. Applicant's status inquiry filed March 3, 2006 is noted.
- 2. Claims 1-21 are pending.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on September 30, 2003 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

5. The drawings were received on September 30, 2006. These drawings are acceptable.

Claim Objections

6. Claims 4 and 6 are objected to because of the following informalities: These claims should, apparently, read "...wherein applying said quantity of sample in liquid state on said at least one sample position...". Appropriate correction is required.

Claim Rejections - 35 USC § 112

- 7. The following is a quotation of the first paragraph of 35 U.S.C. 112:
 - The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
- 8. Claims 8 and 18 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an IR-transparent material as sample carrier, does not reasonably provide enablement for the any and all transparent materials encompassed

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by the broad recitation of "transparent material." The specification does not enable any

person skilled in the art to which it pertains, or with which it is most nearly connected, to

make and/or use the invention commensurate in scope with these claims.

A. The specification discloses only that the sample carrier may be an IR-

transparent material or a roughened metal (see page 8 of the specification). The language

of claims 8 and 18 broadly encompass more than these materials and the specification does

not enable one of ordinary skill to determine which of these other materials is suitable for

use in the invention without undue experimentation.

9. Claims 10 and 20 are rejected under 35 U.S.C. 112, first paragraph, because the

specification, while being enabling for a roughened metal surface as the sample carrier,

does not reasonably provide enablement for the any and all roughened surfaces

encompassed by the broad recitation of "a plate whose surface is roughened." The

specification does not enable any person skilled in the art to which it pertains, or with

which it is most nearly connected, to make and/or use the invention commensurate in scope

with these claims.

A. As noted above, the specification discloses only that the sample carrier may

be an IR-transparent material or a roughened metal (see page 8 of the specification). The

language of claims 10 and 20 broadly encompass more than these materials and the

specification does not enable one of ordinary skill to determine which of these other

materials is suitable for use in the invention without undue experimentation.

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10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly

claiming the subject matter which the applicant regards as his invention.

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- 11. Claims 2 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- A. The term "fine" in claims 2 and 15 is a relative term which renders the claim indefinite. The term "fine" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear just what the term is meant to imply: the degree of resolution, degree of intricacy of pattern, etc. Further, it is unclear what degrees of fineness are included within the scope of the invention.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
- 13. Claims 1, 4, 5, 11, 12, 13, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Eipel et al. (US 2003/0143316 A1).
- A. This reference teaches a method for the application of a quantity of a liquid sample or samples to a substrate in the form of a pattern of extremely small liquid quantities or dots spaced apart from each other [0002, 0015, and 0021].

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B. While this reference does not explicitly disclose subsequent spectroscopic analysis, it is the examiner's position that this limitation, appearing only in the preamble, does not carry any patentable weight because: (1) this limitation is not essential to understand limitations or terms in the claim body; (2) the preamble has not yet been relied upon during prosecution to distinguish the invention over the prior art; and (3) the claim body describes a complete invention (method) such that deletion of the preamble phrase does not effect the recited method steps of the claimed invention.

C. While this reference does not explicitly teach drying of the sample applied to the substrate, it is the examiner's position that such drying is inherent as a certain evaporation of the liquid into the ambient atmosphere is inherent and such anticipates the broad recitation of "drying."

Claim Rejections - 35 USC § 103

- 14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 15. Claims 2, 3, 6-10, and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eipel et al. (US 2003/0143316 A1).
- A. With respect to claims 2, 3, 15, and 16, the amount, arrangement, and density of the dots on the sample carrier are result-effective variables effecting the amount of sample that can be analyzed. Consequently, it would have been obvious to one of

¹ Catalina Marketing International, Inc. v. Coolsavings.com, Inc., 62 USPQ2d 1781 (CAFC 2002)

ordinary skill in the art to optimize these result-effective variables by routine experimentation, absent evidence of their criticality.²

- B. With respect to claims 6 and 14, it is well-known in the coating art to repeat application of a coating material in order to build up a desired thickness. Such would have been obvious to one of ordinary skill in the art.
- C. With respect to claims 7 and 17, it would have been obvious to one of ordinary skill in the art to heat the sample carrier at least as part of a cleaning/pre-coating process.
- D. With respect to claims 8-10 and 18-20, it is the examiner's position that these are common and conventional substrates that would have been obvious to one of ordinary skill in the art.

Conclusion

16. The prompt development of clear issues in the prosecution history requires that applicant's reply to this Office action be fully responsive (MPEP § 714.02). When filing an amendment, applicant should specifically point out the support for any amendment made to the disclosure, including new or amended claims (MPEP §§ 714.02 & 2163). A fully responsive reply to this Office action, if it includes new or amended claims, must therefore include an explicit citation (i.e., page number and line number) of that/those portion(s) of the original disclosure which applicant contends support(s) the new or amended limitation(s).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571)

² MPEP 2144.05

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272-1419. The examiner can normally be reached on Monday through Friday, 0900h-

1700h.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

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Representative or access to the automated information system, call 800-786-9199 (IN USA

OR CANADA) or 571-272-1000.

William Phillip Fatcher III
Patent Examiner (FSA), USPTO

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Fredericksburg, VA September 28, 2006